REMARKS

Please note that the claim amendments provided above consists solely of amending claims to include additional limitations as described in the specification. Consequently, no new matter has been added, and no new search is required.

This application is believed to be in condition for allowance because the claims, as amended, are believed to be non-obvious and patentable over the cited references. The following paragraphs provide the justification for this belief. In view of the following reasonings for allowance, the Applicant hereby respectfully requests further examination and reconsideration of the subject patent application.

1.0 Rejections under 35 U.S.C. §102(e):

In the Office Action of March 26, 2003, claims 1-9, 11, 24-25 and 35-36 were rejected under 35 U.S.C. §102(e), as being anticipated by Wang ("***Wang***," U.S. Patent 6,038,333). In addition, claims 37-50 were rejected under rejected under 35 U.S.C. §102(e), as being anticipated by Garland et al. ("***Garland***," Pub. No. US 2002/0023067 A1). A rejection under 35 U.S.C. §102(e) requires that the Applicant's invention was described in patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant. To establish that a patent describes the Applicant's invention, *all of the claimed elements of an Applicant's invention must be considered, especially where they are missing from the prior art*. If a claimed element is not taught in the referenced patent, then a rejection under 35 U.S.C. §102(e) is not proper, as the Applicant's invention can be shown to be patentably distinct from the cited reference.

Further, in accordance with both the M.P.E.P., Chapter 2100, and well settled case law, the PTO is to apply to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, ***taking into account whatever enlightenment by***

way of definitions or otherwise that may be afforded by the written description contained in applicant's specification" (emphasis added), in re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Further, ***the claim must be interpreted in light of the teachings of the written description and purpose of the invention described therein***. Strattec Sec. Co. v. Gen. Auto. Specialty Co., Inc., 126 F.3d 1411, 1417, 44 USPQ2d 1030, 1034-5 (Fed. Cir. 1997).

1.1 Rejection of Claim 1:

The Office Action rejected independent claim 1 under 35 U.S.C. §102(e) based on the rationale that the ***Wang*** reference discloses the Applicant's claimed "...system for automatically alerting a user to available information ..."

In particular, the Office Action first cites ***Wang*** as disclosing "parsing an electronic document to identify data representing any person (Wang, col. 2, lines 36-45, "A face analysis system is then coupled to the image capturing system and the image database to locate and retrieve the person-identifying data of any stored face image similar to the input face image from the image database. The face analysis system does this by, for example, extracting the face feature data of the input face image and comparing the face feature data of the input face image with that of each of the face images stored in the database", col. 5, lines 5-45, "the input/out system may also include a digital camera that captures the input face image. The digital camera may be replaced, for example, with a scanner... the display is a touch sensitive screen that allows text and or graphics input.");

The Applicant strongly disagrees with the interpretation of the ***Wang*** reference as advanced by the Office Action. In particular, the above cited text appears to ***clearly*** describe a face recognition system that operates on an "input face image" that is captured via either a digital camera or scanner. ***Wang*** then analyzes the input face image face image and compares that face to a database of known faces in order to identify the input face image. Clearly, rather than actually ***parsing*** an electronic

document as described and claimed by the Applicant, ***Wang*** simply performs conventional image recognition on an ***input image***. Further, ***Wang*** does not parse that image in order to perform such image recognition.

For example, the Applicant defines and describes scanning or parsing of an electronic document in paragraphs [51] and [52] as follows:

> "In accordance with the present invention, ***scanning an electronic document (Box 300) comprises using conventional techniques to scan or parse a document to identify any information (Box 310) that may represent a person***. Preferably the ***electronic document is anything that is rendered on the user's computer screen or display device, such as, for example, a word processor document, an Internet Web page, a spreadsheet, or any other textual or graphical data that is rendered on the display device***. However, in one embodiment, the electronic document is ***any type of electronic file that is stored in or on a computer readable storage medium***..." "...***when scanning or parsing an electronic document*** (Box 300), the scanning module (210 of FIG. 2) ***looks for text (Box 320) representing data, such as, for example, a name, email address, or phone number***. As each of these items is typically associated with a person, the person is capable of being identified based on that association. Alternately, the scanning module (210 of FIG. 2) looks for ***an image (Box 320) embedded within an electronic document...***" (emphasis added).

Clearly, the Applicant is describing and claiming examining an electronic document, either displayed on a computer screen, or stored on a computer readable storage medium. During this examination, ***the Applicant's system looks for information embedded in the document that represents a person***. Once such information is identified in the document, then that information is processed to identify any persons represented by the identified data. While such processing may include, in one embodiment, image recognition for an image embedded in an electronic document,

the Applicants neither describe nor claim directly inputting an image for image recognition.

Further, the applicants claimed "parsing an electronic document" must be interpreted in light of the specification. Consequently, the meaning ascribed to this term should be clear in view of the above cited paragraphs (i.e., paragraphs [51] and [52]). Thus, "parsing an electronic document" should be understood to mean looking through an electronic document for textual information representing a person or for an image ***embedded*** in the electronic document.

In contrast, ***Wang*** does ***not*** parse electronic documents; further, ***Wang*** does not look for information representing a person in electronic documents. In fact, ***Wang*** does not look for information representing a person in electronic documents, because ***Wang*** is designed to operate on images that are already ***known*** to represent a person, and which are provided to the ***Wang*** system, either via a digital camera, or an optical scanner, for purposes of facial recognition. Further, the text of the ***Wang*** fails disclose, teach, or in any way suggest, any mechanism whatsoever for finding text or image data ***embedded*** in an electronic document. In fact, given an electronic document having embedded image data or text, rather than a simple digital image file, it appears that the ***Wang*** system would simply be unable to proceed. Consequently, it is unclear how the Office Action can suggest that ***Wang*** is capable of parsing such documents to identify information representing at least one person.

However, in order to clarify the Applicants claimed invention, the Applicants have amended claim 1 to further define the meaning of "electronic documents" as including any of word processor documents, Internet Web pages, spreadsheets, and any textual or graphical data rendered on a display device. Again, ***Wang*** fails to provide any mechanism whatsoever for actually ***parsing*** electronic documents. Further, it should be clear to those skilled in the art that the Applicants claimed invention has significant advantages over the simple image recognition scheme proposed by ***Wang***. In particular, the Applicant's claimed invention is significantly more flexible in performing

identifications than ***Wang*** by virtue of the fact that the Applicant's system is capable of parsing electronic files in stored to a computer readable medium, or even parsed directly from a display device such as a computer monitor.

Therefore, in view of the preceding discussion, it is clear that the present invention, as claimed by independent claim 1, has elements not taught in the ***Wang*** reference. Consequently, the rejection of claim 1, as amended, under 35 U.S.C. §102(e) is not proper. Therefore, the Applicants respectfully requests reconsideration of the rejection of claim 1 and of dependent claims 2-23 under 35 U.S.C. §102(e) in view of the novel language of claim 1.

In particular, claim 1 includes the following novel language:

> A system for automatically alerting a user to available information comprising:
>
> ***parsing an electronic document***, said electronic documents including any of ***a word processor document, an Internet Web page, a spreadsheet, and any textual and graphical data rendered on a display device***, to identify data representing any person;
>
> identifying at least one person represented by the identified data;
>
> retrieving information relating to each identified person from at least one electronic database; and
>
> notifying the user that the retrieved information is available. (emphasis added)

1.2 <u>Rejection of Claim 5:</u>

The Office Action rejected dependent claim 5 under 35 U.S.C. §102(e) based on the rationale that the ***Wang*** reference discloses "parsing an electronic document to identify data representing a person comprises identifying textual data associated with

any person." The Office Action cites ***Wang***, col. 4, lines 28-40 as describing this capability.

However, in view of the text cited by the Office Action, it appears that the Office Action has a fundamental misunderstanding of the Applicant's claimed invention. In particular, the text of the ***Wang*** reference as cited by the Office Action, col. 4, lines 28-40, describes information that is retrieved from a database ***following*** successful facial recognition of an input image.

In stark contrast, the Applicant is claiming the ability to parse an electronic document to ***identify textual information within that electronic document*** that is associated with any person. Clearly, in view of claim 1, claim 5 ***must*** be interpreted to mean that an electronic document having textual information is examined to identify textual information that is associated with a person, followed by retrieving information relating to persons identified by the textual information from at least one electronic database and notifying the user that the retrieved information is available.

Consequently, in view of the above discussion, it should be clear that the ***Wang*** offers absolutely no capability whatsoever to perform the Applicant's claimed invention, as ***Wang*** is clearly incapable of parsing textual information in an electronic document. Therefore, in view of the preceding discussion, it is clear that the present invention, as claimed by independent claim 1 and dependent claim 5, has elements not taught in the ***Wang*** reference. Consequently, the rejection of claim 5 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicant respectfully requests reconsideration of the rejection of claim 5, and of further dependent claim 6 under 35 U.S.C. §102(e) in view of the novel language of claims 1 and 5.

1.3 Rejection of Claim 24:

The Office Action rejected independent claims 24 "on grounds corresponding to the reasons given above for claim 1." However, as discussed above, the rejection of

claim 1 is not supported by the ***Wang*** reference. Further, it should be noted that claim 24 includes further novel limitations not included in claim 1.

In particular, claim 24 recites the following language:

> A computer-implemented process for automatically providing information on a computer display device, comprising:
>
> ***scanning electronic data being rendered on the computer display device*** to identify information within the electronic data that represents at least one person;
>
> identifying each person represented by the identified information;
>
> retrieving information relating to each identified person from at least one electronic database; and
>
> providing an alert for indicating that the retrieved information is available. (emphasis added)

Note that claim 24 includes the capability to ***directly scan*** information that is ***rendered on a computer display device***. In view of detailed description provided in the Applicant's specification, it should be clear that this is ***not*** interpreted to mean that data being scanned is rendered on the display device, but that the Applicant's system is ***directly scanning the display device itself*** to identify information being rendered on that display device which represents at least one person.

In contrast, ***Wang*** offers absolutely not capability whatsoever for directly scanning a display device to automatically identify information that represents a person. In fact, ***Wang*** only displays information on the display device, or manually enters textual information or signatures via a touch sensitive display (see col. 5, lines 5-45).

Consequently, in view of the above discussion, it should be clear that the ***Wang*** reference offers absolutely no capability whatsoever to perform the Applicant's claimed invention, as ***Wang*** is clearly incapable of directly scanning electronic data being

rendered on a display device for the purpose of identifying information within the electronic data that represents at least one person. Therefore, in view of the preceding discussion, it is clear that the present invention, as claimed by independent claim 24 has elements not taught in the ***Wang*** reference. Consequently, the rejection of claim 24 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicant respectfully traverses the rejection of claim 24, and of dependent claims 25-36. Thus, the Applicant respectfully requests reconsideration of the rejection of claims 24-36 in view of the proceeding discussion.

1.4 Rejection of Claim 37:

The Office Action rejected independent claim 37 under 35 U.S.C. §102(e) based on the rationale that the ***Garland*** reference discloses the Applicant's claimed "...computer executable instructions for dynamically modifying an electronic document rendered on a computer display device..."

In particular, the Office Action cites ***Garland***, Fig. 5A-5F, as disclosing "...dynamically modifying an electronic document rendered on a computer display device, said computer executable instructions comprising: detecting any information in the electronic document that represents at least one person; identifying each person based on a comparison of the detected information to data in at least one electronic database; retrieving data related to each identified person from at least one electronic database; and dynamically modifying the electronic document by changing the appearance of the electronic document for alerting a user that data related to each identified person has been retrieved.

Again, it appears that there is a fundamental misunderstanding of the Applicant's claimed invention. In particular, Fig. 5A-5F of the ***Garland*** reference clearly display a database record viewer and a number of database records that offer varying interactive patient information ***in response to user selection of particular links or menu choices*** within each database record.

However, in stark contrast to the interpretation of the Applicant's claimed invention offered by the Office Action, the Applicant's respectfully suggest that the plain meaning of claim 37 is that an "electronic document ***rendered on a computer display*** device" is automatically examined for "***detecting any information in the electronic document*** that represents at least one person." This detected information is then used for "identifying each person based on a comparison of the detected information to data in at least one electronic database." Finally, the Applicant's claimed invention continues by "retrieving data related to each identified person from at least one electronic database; and dynamically modifying the electronic document by changing the appearance of the electronic document for alerting a user that data related to each identified person has been retrieved."

Clearly, as with claim 24, claim 37 is describing a capability to ***directly scan*** information that is ***rendered on a computer display device***. In view of detailed description provided in the Applicant's specification, it should be clear that this capability is ***not*** interpreted to mean that data is dynamically retrieved from a database following user interaction with a database record viewer and a number of database records that offer varying interactive patient information ***in response to user selection of particular links or menu choices***. In fact, as described above, it should be clear that the Applicant's system is ***directly scanning the display device itself*** to identify information being rendered on that display device which represents at least one person. Thus, as with the ***Wang*** reference, it should be clear that the ***Garland*** reference fails to offer any capability whatsoever for directly scanning a display device to automatically identify information that represents a person, and then to act on that information by identifying the persons and retrieving information relating to those identified persons.

Consequently, in view of the above discussion, it should be clear that the ***Garland*** reference offers absolutely no capability whatsoever to perform the Applicant's claimed invention, as ***Garland*** is clearly incapable of directly scanning electronic data being rendered on a display device for the purpose of identifying information within the electronic data that represents at least one person. Therefore, in view of the preceding

discussion, it is clear that the present invention, as claimed by independent claim 37 has elements not taught in the ***Garland*** reference. Consequently, the rejection of claim 37 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicant respectfully traverses the rejection of claim 37, and of dependent claims 38-50. Thus, the Applicant respectfully requests reconsideration of the rejection of claims 37-50 in view of the proceeding discussion, and the novel language of claim 37 as follows:

> A computer-readable medium having computer executable instructions for dynamically modifying an electronic document rendered on a computer display device, said computer executable instructions comprising:
>
> ***detecting any information in the electronic document that represents at least one person***;
>
> ***identifying each person based on a comparison of the detected information to data in at least one electronic database***;
>
> retrieving data related to each identified person from at least one electronic database; and
>
> dynamically modifying the electronic document by changing the appearance of the electronic document for alerting a user that data related to each identified person has been retrieved. (emphasis added)

1.5 <u>Rejection of Claim 49:</u>

The Office Action rejected dependent claim 49 under 35 U.S.C. §102(e) based on the rationale that the ***Garland*** reference discloses the Applicant's claimed invention as claimed in claims 37 and 46, and in particular, that ***Garland*** discloses "...automatically indicating an online status of each identified person." The Office Action again cites ***Garland***, Fig. 5A-5F, as disclosing this capability.

However, as described above, Fig. 5A-5F of the ***Garland*** reference clearly display a database record viewer and a number of database records that offer varying interactive patient information ***in response to user selection of particular links or***

menu choices within each database record. Further, ***Garland*** does ***not*** describe, teach, or in any way suggest determining an online status of an identified person as described and claimed by the Applicant.

In particular, "indicating an online status" described by the Applicant should be understood to mean "checking the online status of the identified person..." by determining whether the identified person is currently logged on to a network or the Internet..." and "...where an identified person either goes offline, or comes online, this information will be reflected in the status..." (see paragraph [58] and [62]).

Clearly, neither Fig. 5A-5F of the ***Garland*** reference, nor any part of the ***Garland*** reference describes, teaches, or in any way suggests determining and indicating an online status of a person, and ***Garland*** offers no mechanism whatsoever for determining whether any identified person is logged onto a network or the Internet.

Therefore, in view of the preceding discussion, it is clear that the present invention, as claimed by independent claim 49 has elements not taught in the ***Garland*** reference. Consequently, the rejection of claim 49 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicant respectfully traverses the rejection of claim 49. Thus, the Applicant respectfully requests reconsideration of the rejection of claim 49.

2.0 Rejections under 35 U.S.C. §103(a):

In the Office Action of March 26, 2003, claims 10, 12 and 16-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over ***Wang***. In addition, claims 13-15, 20-23 and 26-34 were rejected under 35 U.S.C. §103(a) as being unpatentable over ***Wang*** in view of ***Garland***.

In order to deem the Applicant's claimed invention unpatentable under 35 U.S.C. §103(a), a prima facie showing of obviousness must be made. However, as fully explained by the M.P.E.P. Section 706.02(j), to establish a prima facie case of

obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation***, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, ***to modify the reference or to combine reference teachings***. Second, there must be a ***reasonable expectation of success***. Finally, ***the prior art reference (or references when combined) must teach or suggest all the claim limitations***.

Further, in order to make a prima facie showing of obviousness under 35 U.S.C. 103(a), ***all*** of the claimed elements of an Applicant's invention must be considered, ***especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists***. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

2.1 Rejection of Claims 10, 12 and 16-19:

Claims 10, 12 and 16-19 were rejected under 35 U.S.C. §103(a) based on the rationale that ***Wang*** discloses the underlying parent claim, i.e., claim 1, and that the elements of the dependent claims, i.e., claims 10, 12 and 16-19 are obvious in view of ***Wang***.

However, as discussed above with respect to the rejection under 35 U.S.C. §102(e) of independent claim 1, which is the parent claim of claims 10, 12 and 16-19, ***Wang*** fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claim 1 has been shown to be patentable over the ***Wang*** reference, dependent claims 10, 12 and 16-19 must also be patentable over the ***Wang*** reference.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited above. Therefore, the Applicants respectfully request reconsideration of the rejection of claims 10, 12 and 16-19 under 35 U.S.C. §103(a) over ***Wang*** in view of the non-obviousness of claim 1, as amended.

2.2 Rejection of Claims 13-15 and 20-23:

Claims 13-15 and 20-23 were rejected under 35 U.S.C. §103(a) based on the rationale that ***Wang*** discloses the underlying parent claim, i.e., claim 1, and that the elements of the dependent claims, i.e., claims 10, 12 and 16-19 are obvious in view of ***Wang*** and ***Garland***.

However, as discussed above with respect to the rejection under 35 U.S.C. §102(e) of independent claim 1, which is the parent claim of claims 13-15 and 20-23, ***Wang*** fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claim 1 has been shown to be patentable over the ***Wang*** reference, dependent claims 10, 12 and 16-19 must also be patentable over the ***Wang / Garland*** combination where there is no valid rejection of the parent claim.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited above. Therefore, the Applicants respectfully request reconsideration of the rejection of claims 13-15 and 20-23 under 35

U.S.C. §103(a) over ***Wang*** in view of ***Garland*** in view of the non-obviousness of claim 1, as amended.

2.3 Rejection of Claims 26-34:

Claims 26-34 were rejected under 35 U.S.C. §103(a) based on the rationale that ***Wang*** discloses the underlying parent claim, i.e., claim 24, and that the elements of the dependent claims, i.e., claims 26-34 are obvious in view of ***Wang*** and ***Garland***.

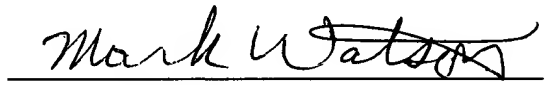
However, as discussed above with respect to the rejection under 35 U.S.C. §102(e) of independent claim 24, which is the parent claim of claims 26-34, ***Wang*** fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claim 24 has been shown to be patentable over the ***Wang*** reference, dependent claims 26-34 must also be patentable over the ***Wang*** / ***Garland*** combination where there is no valid rejection of the parent claim.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 24, as cited above. Therefore, the Applicant respectfully traverses the rejection of claims 26-34 under 35 U.S.C. §103(a) over ***Wang*** in view of ***Garland*** in view of the non-obviousness of claim 24. Thus, the Applicant respectfully requests reconsideration of the rejection of claims 26-34 in view of the novel language of claim 24, as cited above.

CONCLUSION

In view of the above, it is respectfully submitted that claims 1-50 are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1-50 and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

Respectfully submitted,



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